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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/501,947

08/27/2004

Yoshio Umezawa

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EXAMINER

BURKHART, MICHAEL D

ART UNIT

PAPER NUMBER

1633

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|  |  |   |  |
|--|--|---|--|
| <p align="center"><b>Advisory Action</b><br/><b>Before the Filing of an Appeal Brief</b></p> | <p><b>Application No.</b><br/>10/501,947</p> | <p><b>Applicant(s)</b><br/>UMEZAWA ET AL.</p> |  |
|  | <p><b>Examiner</b><br/>Michael Burkhart</p>  | <p><b>Art Unit</b><br/>1633</p>               |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 24 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-5,7,9-14,21-26.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☒ Other: See Continuation Sheet.

/Michael Burkhart/  
, Art Unit 1633

Continuation of 3. NOTE: Claim 1 has been amended to recite that the test protein does not directly interact with the organelle-targeting signal peptide of the fusion peptide (a). This limitation was not previously recited in the claims and thus requires new search and consideration, at the least, against the prior art of record and the instant specification for support of the limitation.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants arguments rely upon entry of the amendment to claim 1. Because the amendment has not been entered, these arguments are moot. It is also noted that claims 5, 7, 9-14, 21 and 22 have not been so amended, thus, they stand rejected for reasons set forth in the Final Office Action, specifically:

Claims 1-5, 7, 9-14 and 21-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 4-8 of U.S. Patent No. 7,166,447 in view of Ozawa et al (Anal. Chem., 2001, Vol. 73: pp. 2516-2521), Hamilton et al (U.S. Patent 6,780,599, effective filing date 5/12/2000), Simpson et al (EMBO reports, 2000), and Martoglio et al (TICB, 1998). ;

Claims 1-5, 7, 9-14 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umezawa et al (WO 02/08766, 1/31/2002) as applied to claims 6, 8, 17, and 19 above, and further in view of Ozawa et al (Anal. Chem., 2001, Vol. 73: pp. 2516-2521), Hamilton et al (U.S. Patent 6,780,599, effective filing date 5/12/2000), Simpson et al (EMBO reports, 2000), and Martoglio et al (TICB, 1998). ;

and, Claims 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods wherein a fusion peptide (b) (e.g. as recited in claim 1) comprises a test protein, and vectors encoding such fusion peptides, does not reasonably provide enablement for such methods or vectors wherein the test protein is merely bound to the fusion peptide (b), or bound to the vector encoding fusion peptide (b). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Continuation of 13. Other: The terminal disclaimer filed on 6/24/2008 has not been considered because applicant failed to provide a showing of good and sufficient reasons why the terminal disclaimer was not earlier presented.